Exhibit 5

Attorney Docket DX-3 (#90545)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of:
Application Serial No. 75/701,707
Mark: Drawing of a Marine Heat Exchanger
Published in the Official Gazette at Page TM 400 on May 9, 2000

DURAMAX MARINE, LLC)
)
)
vi.) Opposition No. 119,899
)
R.W. FERNSTRUM & COMPANY,)
)
Applicant,)

Box TTAB – No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Opposer's Motion for Summary Judgment and Brief in Support of Motion for Summary Judgment, and any document noted as being enclosed or attached, was served via first class U.S. mail, postage prepaid, on the date noted below to:

Samuel D. Littlepage, Esq.
Dickinson Wright PLLC
1901 L Street, N.W. – Suite 800
Washington, DC 20036-3506

Date: June 27, 2003

By: _____
D. Peter Hochberg

CERTIFICATE OF MAILING

I hereby certify that the foregoing Opposer's Motion for Summary Judgment and Brief in Support of Motion for Summary Judgment, and any document noted as being enclosed or attached, was filed via Express Mail (No. EV203147513US), postage prepaid, on the date noted below to: Box TTAB – No Fee -, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

Date: June 27, 2003

By: _____
Christine Kotran

Attorney Docket DX-3 (#90545)

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DURAMAX MARINE, LLC	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 119,899
	)	
R.W. FERNSTRUM & COMPANY,	)	
	)	
Applicant	)	

OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Box TTAB – No Fee
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2900 Crystal Drive
Arlington, VA 22202-3513

Duramax Marine, LLC (Duramax Marine), by and through its attorneys, herein files its Motion and Brief in Support of Motion for Summary Judgment. As will be shown below, no material issues of fact exist and Duramax Marine, the moving party, is entitled to judgment as a matter of law.

The accompanying brief supports this Motion.

Respectfully submitted,

Date: June 27, 2003

By: _____
D. Peter Hochberg
Reg. No. 24,603
Counsel for Opposer

Attorney Docket DX-3 (#90545)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In the Matter of:
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Applicant,	)	

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BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

I. Introduction

R.W. Fernstrum & Company ("Fernstrum") filed a service mark application to register a line drawing which is a line picture of one of its many models of marine heat exchangers, and Duramax Marine, LLC ("Duramax Marine") has opposed the application. The grounds on which Duramax Marine has filed this Motion for Summary Judgment are twofold. First, Fernstrum cannot obtain a registration of a picture of the very product that Fernstrum manufactures and sells. Second, the results of a survey filed by Fernstrum in support of its effort to change the basis of its application from Section 2(e)(1) to Section 2(f) of the Trademark Act was fatally defective in that the survey was not based on the mark which is the subject of Serial No. 75/701,707.

II. The Standard for Summary Judgment

Summary Judgment is proper where the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). See also *Celotex v. Catrett,* 477 U.S. 317 (1986). The party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. *Copelands' Enterprises, Inc. v. CNV Inc.*, 945 F.2d 1563, 20 U.S.P.Q.2d 1295 (Fed. Cir. 1991). The burden of the moving party may be met by showing "that there is an absence of evidence to support the nonmoving party's case." *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). On Summary Judgment, the nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist; and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 U.S.P.Q.2d 2027 (Fed. Cir. 1993). However, the party opposing the motion may not raise a purported issue of fact by mere allegations or denials. *Lujan v. National Wildlife Federation*, 497 U.S. 871, 888 (1990). The opposing party must refer to the record to demonstrate some actual material fact dispute. *First Commodity Traders, Inc. v. Heinold Commodities, Inc.*, 766 F.2d 1007, 1011 (7th Cir. 1985).

III. The Undisputed Facts

Fernstrum obtained U. S. Patent No. 2,382,218 (Ex. 1, Dep. Ex. 61)[1] on a marine heat exchanger, also called a keel cooler, in 1945. This patent is directed to a one-piece keel cooler and basically describes a unit having a pair of headers or manifolds between which extend parallel coolant flow tubes which are rectangular in cross section and whose upper and lower surfaces are parallel. Each header has a nozzle for connection to tubes which are connected to a ship's engine or other heat-generating source. The headers and flow tubes are located on the bottom or sides of a boat or ship below the ambient water line. Hot coolant flows from the engine, through the nozzle to one of the headers, and through the rectangular flow tubes to the second header. The coolant is cooled by the ambient water, and the cooled coolant flows through the nozzle in the second header and back to the engine in a circulatory fashion. The keel cooler disclosed in U.S. Patent No. 2,382,218 is very compact as set forth in Fernstrum's numerous advertisements, has no moving parts and has been the main (for all but about the last six years) and only source of one-piece keel coolers in the United States. Fernstrum has called its one-piece keel cooler a "GRIDCOOLER" and obtained U.S. Trademark Registration No. 941,382 (Ex. 2, Dep. Ex. 22) in 1972 for the trademark GRIDCOOLER for use on marine heat exchangers. Even though U.S. Patent No. 2,382,218 expired in 1962, Fernstrum had a virtual monopoly on one-piece keel coolers until about 1997. (Ex. 3, R.W. Fernstrum & Company Dep., pp. 31-32)[2]

[1] Exhibits are identified by their Exhibit number for this Brief, and by deposition exhibit number. Pages as needed are indicated by the four digit Bates number.

[2] Deposition transcript exhibits are identified by the name of the deponent (S. Fernstrum is Sean Fernstrum, T. Fernstrum is Todd Fernstrum, P. Fernstrum is Paul Fernstrum), and page numbers of the deposition transcript.

In 1997, Fernstrum terminated its distributorship arrangement with Donovan Marine, Inc., a company in New Orleans, Louisiana. Donovan Marine is a large marine equipment distributor for the Gulf states, and was a major factor in introducing and developing the market in those states for Fernstrum's Gridcoolers. Fernstrum decided to cut the distributorship rights of Donovan Marine to some of its long-established customers for the Gridcoolers. Fernstrum entered into a distribution contract with another company and canceled Donovan Marine's distributorship. Donovan Marine brought a lawsuit in the State of Louisiana against Fernstrum on a number of grounds, including restraint of trade, unfair and deceptive trade practices, and breach of contract. (Ex. 4, Petition for Damages) In addition, Donovan Marine contacted Johnson Marine (i.e., Duramax Marine), a division of the predecessor of Duramax Marine, with whom it had done business for many years, including distributing various marine products including a demountable keel cooler, a multi-part and less compact unit than Fernstrum's keel coolers for comparable coolant flow rates, to determine if Duramax Marine could supply one-piece keel coolers like the GRIDCOOLER. Since Fernstrum's U.S. Patent No. 2,382,218 had expired about 35 years earlier, there was no legal reason why Duramax Marine or any other third party could not make or have made such a unit. The foregoing is summarized in the "Order and Reasons" from U.S. District Court Judge Lemmon, pp. 2-4. (Ex. 5).

Duramax Marine sent newly designed keel coolers to Donovan Marine for sale to Donovan Marine's customers. (Ex. 4, pp. 2-4) Donovan Marine removed the pending litigation from the Louisiana state court to the U.S. District Court in New Orleans. Donovan Marine's "First Amended and Supplemental Complaint" is attached as Exhibit 6. Fernstrum filed a counterclaim against Donovan Marine for trade dress infringement,

unfair competition and dilution. (Ex. 7) Fernstrum alleged that Donovan Marine had infringed the three-dimensional trade dress in which Fernstrum allegedly had a proprietary interest on the parallel flow tubes with the rectangular cross section which Fernstrum incorporated in its GRIDCOOLER.

Fernstrum also filed U.S. trademark Serial No. 75/382,250 (Ex. 8, Dep. Ex. 70) on the three-dimensional configuration of the flow tubes in the GRIDCOOLER. A comparison of the drawing in Serial No. 75/382,250 (Ex. 8, Dep. Ex. 70, p. 0496d) with the drawing in U.S. Serial No. 75/701,707 (Ex. 9, Dep. Ex. 2, p. 0069), the trademark application in the present opposition, shows that these are the same drawing with the dotted lines in the former application having been converted to solid lines.

East Park Radiator and Battery Shop, Inc. ("East Park"), a company in Houma, Louisiana, was in the business of repairing Fernstrum's Gridcoolers for customers who had bought them, and used in its advertisements a picture of the GRIDCOOLER keel cooler (which is the subject of the present opposition) as well as the trademark GRIDCOOLER. Fernstrum sent a warning letter to East Park to stop using both the picture of the GRIDCOOLER and the trademark GRIDCOOLER, and to stop selling keel coolers substantially like Fernstrum's GRIDCOOLER. (Ex. 10) Fernstrum commenced litigation in the U.S. District Court in the Eastern District of Louisiana against East Park alleging infringement of Fernstrum's alleged trade dress rights to the three-dimensional configuration of the parallel coolant flow tubes with the rectangular configuration, unfair competition and dilution. (Ex. 11)

The U.S. District Court in New Orleans consolidated the two lawsuits between Donovan Marine and Fernstrum and between East Park and Fernstrum under Civil Action 97-3598. Duramax Marine, with Fernstrum's knowledge, assisted Donovan Marine in the

lawsuit in the U.S. District Court in New Orleans with respect to the trademark and trade dress grounds. The essence of Donovan Marine's defense was that one could not obtain trade dress protection of a functional unit, and that the parallel coolant flow tubes with the rectangular cross section were purely functional. Donovan Marine noted to the District Court that the patent which had protected the flow tubes with the rectangular cross section had expired many years earlier, and that Fernstrum had no proprietary interest in their design.

After Duramax Marine began supplying its keel cooler to Donovan Marine, it commenced research and development to design a keel cooler which increased the temperature of the coolant flowing through the keel cooler without having excessive pressure drops of the coolant. Duramax Marine developed a new keel cooler having improved physical characteristics for increasing the flow through the keel cooler and was awarded U.S. Patent No. 6,575,227 (Ex. 12) as one result of its efforts. The new keel cooler has beveled portions on the lower fore and aft ends of the header as described in the latter patent. Duramax Marine adopted the trademark DURACOOLER for its new keel cooler.

The consolidated case of *Donovan Marine v. Fernstrum* and *Fernstrum v. East Park* was set for trial in May, 1998, in the U.S. District Court in New Orleans. Judge Lemmon was the presiding judge. After Fernstrum presented its case and prior to either Donovan Marine or East Park were to present their cases, Judge Lemmon instructed Fernstrum to attempt to settle the litigation. Fernstrum had settlement meetings with Donovan Marine, East Park and Duramax Marine since it had failed to meet its burden of proof on any of its claims and counterclaims.

Since Duramax Marine had designed its new keel cooler (the DURACOOLER) with the beveled headers, it agreed to execute a Settlement and Mutual Release Agreement attached as Exhibit 13. In this settlement agreement, Duramax, Inc. (Duramax Marine was formerly a division of Duramax, Inc. but became a separate and independent corporation in 1997) agreed to modify their keel coolers to adopt the beveled fore and aft header portions as shown on Exhibit 1 of the settlement agreement. There was no compelling reason for East Park and Duramax, Inc. to make this change, but it was an important design feature of the new keel cooler (the DURACOOLER) of Duramax, Inc. Fernstrum agreed in the settlement agreement to withdraw, with prejudice, its trademark application Serial No. 75/382,250 to register the configuration of its one-piece keel cooler as was then pending before the Trademark Trial and Appeal Board. Although the parties to the settlement agreement agreed that Fernstrum could file a new application to register its trademark logo featuring its one-piece keel cooler in a two-dimensional design format, there was nothing agreed to or provided in the settlement agreement to preclude the filing and prosecution of an opposition to such a trademark logo.

After the trial in the U.S. District Court in New Orleans, Duramax Marine continued to sell the DURACOOLER, and one of its advertisements referred to the approved keel cooler as the best and most efficient in industry. It used the term "Best By Test." Fernstrum continued its attempt to restrict the activities of Duramax Marine in the market by filing a complaint against Duramax Marine in the U.S. District Court for the Western District of Michigan under Civil Action No. 2:00CV194 before Richard A. Enslen, Chief U.S. District Judge (Ex. 14). Fernstrum alleged that an advertisement by Duramax Marine entitled "DURACOOLER – the Best By Test" states that the

DURACOOLER "is the most efficient keel cooler in the industry." Fernstrum alleged that these statements were "literally false." Fernstrum alleged that the "Test" referred to by Duramax Marine was "literally false," deceitful and "an unqualified superiority claim that is a false and misleading representation of fact." Fernstrum included in its complaint four counts, a federal false advertising claim under 15 U.S.C. § 1125(a), a state of Michigan claim for deceptive advertising, a claim for deceptive trade practice under Michigan law, and an unjust enrichment claim. A hearing for a preliminary injunction was held in Kalamazoo, Michigan, on December 5, 2000, before Judge Enslen. Fernstrum called no witnesses for the hearing, but Duramax Marine called Michael Brakey, who testified before Judge Enslen and was cross-examined by counsel for Fernstrum.

Judge Enslen's decision entitled "Court's Ruling Regarding Motion for Preliminary Injunction" was issued from the bench, and a copy of his decision is attached as Exhibit 15. Judge Enslen made the following statements with respect to the alleged falsity in Opposer's advertising:

> In this case, the context for regarding these advertising claims is not the large consuming public, but rather a small group of very technically informed naval architects, marine engineers, shipwrights and large boat owners....In the context of naval architects, marine engineers, shipwrights, and large boat owners, such buyers are unlikely to find the defendant's testing claims were literally false or that the testing either was unreliable or otherwise insufficient to prove the propositions asserted.

The court denied Applicant's request to enjoin Duramax's use of the "Best By Test" because it believed that Applicant could not establish the literal falsity of Opposer's claims.

After Applicant lost its motion for preliminary injunction in the Western District of Michigan, it dismissed its case in that court and relinquished its claims for both

damages and injunctive relief. The Applicant then filed yet another complaint with the National Advertising Division ("NAD") of the Council of Better Business Bureaus alleging again that Opposer's "Best By Test" advertising campaign was false and could not be substantiated (which clearly was an untrue statement since it had seen the declarations of Messrs Brakey and Krawczyk (a computer expert on coolant flow).

Opposer changed its advertising regarding its new keel cooler as it would have done in any event since in the ordinary course of business it changes its advertising after an advertising campaign has been in use for periods of time. The NAD decided that it lacked jurisdiction to review the challenged claims on the merits on other grounds. It stated that Opposer had discontinued the advertising in issue and administratively closed the challenge. See the letter dated May 14, 2001 from Peter C. Marinello, Associate Director of the NAD, attached hereto as Exhibit 16.

Fernstrum filed U.S. Serial No. 75/701,707 (Ex. 9, Dep. Ex. 2), the service mark application being opposed herein, on May 10, 1999. This trademark application had essentially the same drawing as that in Serial No. 75/382,250 (Ex. 8, Dep. Ex. 70). Whereas the latter application was directed to a three-dimensional configuration of the parallel coolant flow tubes having a rectangular cross section, Serial No. 75/701,707 was stated in the application as being for the following "goods" [sic]: "manufacture of marine heat exchangers to the order and specification of others." Attached as specimens to application Serial No. 75/701,707 were three advertisements (Ex. 9, Dep. Ex. 2, pp. 0070-0071), each being shaded to either represent photographs or at least to show the keel cooler in a very realistic condition. An Office action was issued on November 8, 1999, in which Examining Attorney Jill C. Alt refused to register the mark because she stated that it was merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C.

§ 1052(e)(1), on the ground that the proposed mark is merely descriptive in that it consists of a representation of an important feature or characteristic of the services. The Office Action further stated that a mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services citing cases and referring to TMEP § 1209.01(b). The Examining Attorney said

> Applicant seeks to register a fairly straightforward representation of its marine heat exchanger for custom manufacture of marine heat exchangers. A picture of the product applicant is custom manufacturing is telling a great deal about what the product looks like but indicates very little about the commercial source of the product....
>
> It is extremely dubious whether any among the relevant buying public will perceive the proposed mark as a service mark. Applicant's specimens make it appear as if the term 'GRIDCOOLER' is the trademark for the goods and that the pictorial representation on the promotional piece is a picture of a 'GRIDCOOLER'.

The Examining Attorney further refused to register the trademark because she said that the proposed mark does not function as a service mark to identify and distinguish the applicant's services from those of others and to indicate their source. She went on to make the following statement:

> The mark appears to be a pictorial representation of applicant's marine heat exchangers, the product of its custom manufacturing service. It shows a customer what the goods look like, perhaps. It is informative in this regard. However, in the specimens of use, the pictorial representation appears to be just that – a picture of the goods. The trademark for the goods appears to be 'GRIDCOOLER,' and the picture or drawing is just a picture of a 'GRIDCOOLER' and not a symbol of custom manufacturing services.

Fernstrum filed a reply to the foregoing Office Action on December 22, 1999. In the response, Fernstrum amended the application to seek registration under § 2(f) of the Lanham Act, 15 U.S.C. § 1052(f). Fernstrum supported its claim that the design of a heat

exchanger has "acquired distinctiveness or secondary meaning" by its submission of *A Survey of Secondary Meaning of the Shape and Appearance of the Fernstrum Keel Cooler Tubing* by the Sorensen Marketing/Management Corporation (September, 1998) (Ex. 9, Dep. Ex. 2, pp. 0083-0177). Fernstrum was able to convince the examining attorney that this survey was relevant in establishing acquired distinctiveness. In the foregoing response, Fernstrum, through its attorney, made the following statement:

> The purpose of the survey was to determine whether the appearance of the heat exchanger had acquired secondary meaning. Survey, at p. 3....The interview subjects were shown three photographs of the tubing of the heat exchanger and instructed to look at them as if they were examining a catalogue or brochure. Survey, at p. 8.

What Fernstrum did not tell the examining attorney was that this survey was taken for a different purpose, namely the litigation which Fernstrum was involved with Donovan Marine, East Park and (in effect) Duramax Marine, in its unsuccessful attempt to enforce its alleged proprietary interest in the three-dimensional configuration of the coolant flow tubes with the rectangular configuration. Those being interviewed for the survey were not shown the service mark that is the subject of the application being opposed, and the survey was in addition taken at a time when Fernstrum had almost the entire market for one-piece keel coolers in the United States. The Sorensen survey is 94 pages long, and pages 0111-0113 are photographs of what the survey interviewees were shown. These are unclear photographs, but they clearly only show a photograph of the coolant flow tubes and not the headers and, therefore, not the subject of the present trademark application.

Serial No. 75/701,707 was published for opposition on May 9, 2000 (Ex. 17).

Fernstrum has been actively advertising its GRIDCOOLER keel cooler for over 50 years. In a great many of its advertisements, Fernstrum shows pictures of its keel

cooler. Deposition Exhibit 3, which was submitted by Fernstrum in response to Duramax Marine's requests for all documents relating to the creation, selection, adoption, and contemplated or actual use of the service mark which is the subject of the present opposition (referred to during discovery as the "Keel Cooler Drawing"), includes pages 1-296 (Ex. 18, Dep. Ex. 3, pp. 0198-0494). Fernstrum supplied a page showing an early use of the trademark. (Ex. 18, Dep. Ex. 3, p. 0204) It will be seen that this picture may be a photograph or an artist's rendition of a keel cooler resembling a photograph due to the reflective surfaces shown on the unit. In response to Duramax Marine's Interrogatory No. 11 requesting Fernstrum to identify and provide a specimen of each form of planned or actual use of the mark by Fernstrum, Fernstrum submitted Document Nos. 1-84 as "representative specimens showing actual use of the mark." (Ex. 19, Int. 11 and Doc. Nos. 1-84 in response to Int. 11) These specimens show the GRIDCOOLER keel cooler facing in different directions (see Document Nos. 2, 3, 4 and 5 in Ex. 19, for example). The depicted keel coolers of Fernstrum generally show a keel cooler having opposite headers with nozzles extending upwardly therefrom and separated by a set of eight parallel coolant flow tubes having rectangular cross sections. The drawings of the keel coolers are extremely similar to pictures of actual keel coolers. See Document Nos. 30 and 38 in Exhibit 19 showing part of a GRIDCOOLER keel cooler having eight coolant flow tubes. In Fernstrum's "Installation and Maintenance Form 155," Document Nos. 45-51, (Ex. 19), it can be seen on Document No. 49 that the method of attaching a zinc electrode plate is shown where the keel cooler has eight coolant flow tubes and, since the unit is shown upside down, the nozzle is extending downwardly. Fernstrum's catalogue 995, Document Nos. 57-63 (Ex. 19), the GRIDCOOLER keel cooler is shown in front of a globe. Fernstrum has another trademark application pending on the GRIDCOOLER in

front of a globe (Ex. 20, Serial No. 75/715,815), and Duramax Marine did not oppose that application. Considering only the GRIDCOOLER itself in Exhibit 19, it can be seen that this picture is either made from a photograph or an artist's rendition making it appear to be a photograph.

Fernstrum's web site (www.fernstrum.com) shows pictures of the GRIDCOOLER keel cooler in color, with the reflection being most apparent and leading one to believe that the picture is a photograph of the GRIDCOOLER itself (which it may be). (Ex. 21, Dep. Ex. 5, pp. 0760-0791, especially pp. 0764-0766)

Fernstrum's current catalogue 2002 (Ex. 22, Dep. Ex. 12, pp. 0967-0974) shows various photographs or pictures of Fernstrum's keel cooler products, and each of them may have been photos or could have been made from photos. (Ex. 23, P. Fernstrum Dep., p. 107). The color Catalog 2002 entitled *Fernstrum GRIDCOOLER®* shows the Fernstrum keel coolers in virtually photographic form. (Ex. 24)

Fernstrum used drawings nearly identical to those in the trademark application involved in the present opposition in obtaining U.S. Patent No. 4,338,993. (Ex. 25, Dep. Ex. 13) Figure 1 is nearly identical to that of U.S. trademark Serial No. 75/701,707. A patent applicant is required to disclose the preferred embodiment of his invention, and that is what is shown in the '993 patent. One small difference is in the number of coolant flow tubes, since the '993 patent shows ten flow tubes rather than the eight of the application under opposition.

Fernstrum's GRIDCOOLER keel cooler is entirely functional. There is nothing on it which is merely ornamental. It has nothing on it which is merely a desirable or attractive product feature. (Ex. 26, R.W. Fernstrum & Company Dep., p. 120)

IV. Argument

A. A visual representation which constitutes merely an illustration of one's product is unregistrable under § 2(e)(1) of the Trademark Act.

The drawing which is the subject of Serial No. 75/701,707 is a picture of a keel cooler. Fernstrum has designed somewhere in the neighborhood of 80,000 to 100,000 models of keel coolers. (Ex. 27, R.W. Fernstrum & Company Dep., pp. 155-156) The keel cooler shown in Serial No. 75/701,707 includes a pair of headers between which extend eight coolant flow tubes which are rectangular in cross section. Fernstrum still makes this model of keel cooler. (Ex. 28, P. Fernstrum, Dep. p. 120) A visual representation which constitutes merely an illustration of one's product is unregistrable under § 2(e)(1) of the Trademark Act just as is a merely descriptive word. *In re Underwater Connections, Inc.*, 221 U.S.P.Q. 95 (TTAB 1983); *In re AMF Inc.*, 181 U.S.P.Q. 848 (TTAB 1974); *Godman Shoe Co. v. Dunn & McCarthy, Inc.*, 137 U.S.Q.P. 896 (TTAB 1963); *In Re Ratcliff Hoist Co., Inc.*, 157 U.S.P.Q. 118 (TTAB 1968); *Ex parte Alexander*, 114 U.S.P.Q. 547 (Com'r. Pats. 1957); *GILSON, TRADEMARK PROTECTION AND PRACTICE*, Section 2.03, footnote 9 (2002 ed.).

1. Fernstrum's drawing in the trademark application at issue is an illustration of a product sold by Fernstrum.

The drawing shown in Serial No. 75/701,707 is a sketch of a keel cooler. The keel cooler is basically composed of a pair of headers between which extend a set of eight rectangular coolant flow tubes, and nozzles extend upwardly from each of the headers. A connector in the middle of the tubes holds them together. (Ex. 9, Dep. Ex. 2, p. 0069). This is a line drawing of one of the many models of keel coolers made, marketed and sold by Fernstrum, used in association with its service of "manufacture of marine heat exchangers to the order and specification of others" as set forth in Serial No. 75/701,707. (See, for example, Ex. 18, Dep. Ex. 3, pp. 0212-0215, 0218-0224, 0226-0233, 0260,

0312, 0345-0351, 0358, 0365.) Fernstrum's web site shows in what appears to be photographic form the keel cooler shown in Serial No. 75/701,707 (absent the globe behind the keel cooler). (Ex. 21, Dep. Ex. 5, pp. 0764-0766.) Fernstrum has admitted that it had shown all or part of a keel cooler in its installation instructions. (Ex. 29, Dep. Ex. 6, "Answers to Request for Admissions Nos. 44-57") Fernstrum has allowed pictures of the keel cooler as shown in Serial No. 75/701,707 in trade publications. See Ex. 30, Dep. Ex. 9, and Ex. 31, Dep. Ex. 43.

2. The keel cooler shown in the trademark application at issue is disclosed in U.S. patents.

Fernstrum has used pictures nearly identical to that shown in Serial No. 75/701,707 in its own patent applications, indicating that Fernstrum itself considers the drawing to be merely descriptive. See U.S. Patent No. 4,338,993 (Ex. 25, Dep. Ex. 13) and slight modifications in Fernstrum's U.S. Patent Nos. 6,099,373 (Ex. 32, Dep. Ex. 46) and 5,931,217 (Ex. 33, Dep. Ex. 47). Fernstrum's own blueprints showing various models of its GRIDCOOLER keel cooler show drawings of the product which are similar to those of the drawing in Serial No. 75/701,707 but not in perspective form. (Ex. 34, Dep. Ex. 21)

Not only do the foregoing exhibits clearly show that the drawing of Serial No. 75/701,707 is a drawing of a keel cooler which Fernstrum sells under the trademark GRIDCOOLER, but Fernstrum has admitted that it has used the drawing (or part of the drawing) in its manufacturing and related operations (Ex. 29, Answers to Requests for Admissions 44-51) – indicating that it is a description of the keel cooler which Fernstrum manufactures, sells and to which the services of the present application relate. It is clear that the drawing which is the subject of Serial No. 75/701,707 is merely descriptive of the keel cooler to which the services of the foregoing application relate. This pictorial

representation immediately informs customers that the applicant, Fernstrum, offers services relating to the keel cooler shown in the drawing of the subject application. As such, the drawing should not be registered. *In re Eight Ball, Inc.*, 217 U.S.P.Q. 1183 (TTAB 1983); *GILSON, supra*, Section 2.03 ("A descriptive term ordinarily tells how a product functions, what it looks, tastes, or feels like, or what its desirable characteristics are.").

B. A visual representation which constitutes merely an illustration of one's product is unregistrable with respect to services where the pictorial representation is an important feature or characteristic of the services.

The drawing of the keel cooler shown in Serial No. 75/701,707 is directed to the manufacture of marine heat exchangers to the order and specification of others. The marine heat exchanger is a keel cooler. The keel cooler shown in the application is one of the many models sold by Fernstrum. A visual representation constituting merely an illustration of the applicant's product is unregistrable with respect to the services where the pictorial representation is an important feature or characteristic of the services. *In re Eight Ball, Inc., supra*; *In re Underwater Connections, Inc., supra; Interpayment Services Ltd. v. Docters & Thiede,* 66 U.S.P.Q.2d. 1463, 1466 (TTAB 2003). Fernstrum filed the application for the services set forth in the application rather than for marine heat exchangers. This is different from the registration for the trademark GRIDCOOLER (U.S. Registration No. 941,382, Ex. 2, Dep. Ex. 22), which was registered for "external cooling system for marine engines and installed upon the hulls of watercraft." However, the registration should be refused in the present situation regardless of whether the application is for goods or services.

C. The visual representation of the keel cooler in the trademark at issue is a realistic representation of the goods lacking arbitrary features.

There is no arbitrary matter added to the realistic drawing of a marine heat exchanger or keel cooler, as is clear from an examination of the drawing of Serial No. 75/701,707, and as testified in the deposition of Fernstrum. (Ex. 26, R.W. Fernstrum & Company Dep. p. 120) *In re Underwater Connections, Inc., supra.* As was noted in the latter case, there was nothing such as a humanized peanut (*Planter's Nut & Chocolate Company v. Crown Nut Company, Inc.,* 134 U.S.P.Q. 504 (CCPA 1962), or a plurality of products that was somewhat artful as in *In re AMF Inc., supra.*

D. Fernstrum's effort to change the basis of the application from Section 2(e)(1) to 2(f) of the Trademark Act is invalid because of an improper, misleading and false survey.

There is no evidence that the mark of Serial No. 75/701,707 had acquired distinctiveness under § 2(f) of the Trademark Act because the survey submitted did not show the mark which is the subject of the application.

Referring to the file wrapper of Serial No. 75/701,707 (Ex. 9, Dep. Ex. 2) an amendment was filed on December 22, 1999 (Ex. 9, Dep. Ex. 2, p. 0075 et seq.) in which the applicant Fernstrum replied to the statement by the examining attorney that "It is extremely dubious whether any among the relevant buying public will perceive the proposed mark as a service mark," by stating that the mark had acquired distinctiveness. In response to the descriptiveness refusal, the applicant Fernstrum had amended the application to seek registration under § 2(f) of the Lanham Act. To support its claim of acquired distinctiveness or secondary meaning, the applicant submitted a "*SURVEY OF SECONDARY MEANING OF THE SHAPE AND APPEARANCE of the Fernstrum Keel Cooler Tubing* by the Sorensen Marketing/Management Corporation (September, 1998)." (Ex. 9, Dep. Ex. 2, pp. 0083-0177) Fernstrum stated in the amendment that it had obtained the services of a survey interviewer, a research and consulting company in the

boat building and maintenance industry who conducted over 150 interviews. It was stated in the amendment that the interview subjects were shown three photographs of the tubing of the heat exchanger and were instructed to look at them as if they were examining a catalogue or brochure (Ex. 9, Dep. Ex. 2, pp. 0076-0077). Based on the alleged results of the survey, the applicant Fernstrum requested that the descriptiveness refusal be withdrawn and that the application be approved for publication under § 2(f).

The survey (Ex. 9, Dep. Ex. 2, pp. 0083-0177), which was taken in September, 1998, before Serial No. 75/701,707 was even filed on May 10, 1999, and was done with respect to Fernstrum's unsuccessful attempt to enforce its trade dress infringement claim against Donovan Marine and East Park with respect to the coolant flow tubes in their respective keel coolers, did not show a keel cooler at all. Reference is made to Exhibit 9, Deposition Exhibit 2, pages 0111-0113. These documents are photographs of only the parallel coolant flow tubes having a rectangular cross section used in Fernstrum's GRIDCOOLER. A comparison of these photographs with the drawing in Serial No. 75/701,707 (Ex. 9, Dep. Ex. 2, p. 0069) shows that the essential portions of the keel cooler are omitted. That is, neither header with their nozzles is shown, and the tubes which are shown are respectively submitted as being meaningless with respect to the trademark in question. This deficiency in the trademark should relate to the weight given to the survey's conclusions, even if not to its admissibility, and if those deficiencies are so substantial to render the survey's conclusions untrustworthy, the survey should be excluded from evidence. *Winning Ways, Inc. v. Holloway Sportswear, Inc. et al.*, 913 F.Supp. 1454 (D.KS. 1996; *AHP Subsidiary Holding Co, v. Stuart Hale Co.*, 1 F.3d 611, 618 (7th Cir. 1992); 27 U.S.P.Q.2d 1758; *American Footwear Corp. v. General Footwear Co., Ltd.*, 609 F.2d 655, 660 n4 (2d Cir. 1979), *cert denied*, 445 U.S. 951, 63 L.Ed.2d

787, 100 S.Ct. 1601 (1980); 204 U.S.P.Q. 609; *Bank of Utah v. Commercial Security Bank,* 369 F.2d 19, 27-28 (10th Cir. 1966), *cert denied,* 386 U.S. 1018, 18 L.Ed.2d 456, 87 S.Ct. 1374 (1967); *Jaret Int'l, Inc. v. Promotion in Motion, Inc.,* 826 F.Supp. 69, 73-74 (E.D.N.Y. 1993); 27 U.S.P.Q.2d 1913; *Boehringer Ingelheim GmbH v. Pharmadyne Laboratories,* 532 F.Supp. 1040, 1057-58 (D.N.J. 1980); 211 U.S.P.Q. 1163. Reliance on a faulty survey (or the complete exclusion thereof because it is faulty) causes applicant Fernstrum's claim that the mark has acquired distinctiveness or secondary meaning to fail. Failure to prove such a claim in an application to seek registration under Section 2(f) of the Lanham Act, assuming it is not otherwise registrable, renders the mark unregistrable.

E. The pictorial representation of the keel cooler in Serial No. 75/701,707 is a picture of a purely functional device, and registration should be refused.

Trademark application Serial No. 75/701,707 is extremely close to an application reviewed at length in *In re The Deister Concentrator Company, Inc.,* 289 F.2d 496, 129 U.S.P.Q. 314 (CCPA 1961). In the *Deister Concentrator* case, a trademark application was filed which consisted of a two-dimensional figure of a substantially rhomboidal outline, which was the outline of the top surface of a concentrating or cleaning table, known in the art as a shaking table. A shaking table is used for separating solid particles suspended in a flowing film of water. This was unlike the shape of the top of the tables used by the competitors of the appellant in that case, because the competitors had rectangular decks rather than the rhomboidal shape. Also as to the term of use of the mark in the present case, the appellant had been using its "distinctive outline shape" for more than 50 years and had obtained a registration about 40 years prior to the above decision for the words "DEISTER OVERSTROM Diagonal Deck." The Examiner in that case had rejected it on the ground that it did not appear that the trademark was

capable of distinguishing the applicant's goods from those of others. The applicant filed 30 affidavits and other evidence intended to show that the trade did in fact recognize shaking tables with those particular tops as appellant's goods. The Examiner continued the rejection, saying that the shape of applicant's tabletops was utilitarian and must be characterized as functional. The Board affirmed the rejection stating that the rhomboidal design was functional and could not be a trademark, citing *In re Bourns,* 252 F.2d 582, 117 U.S.P.Q. 38 (CCPA 1958); *Alan Wood Steel Co. v. Watson*, Com'r Pats., 150 F.Supp. 861, 113 U.S.P.Q. 311 (D.C.D.C. 1957).

Judge Rich, delivering the opinion of the CCPA, affirmed the decision of the Board. Judge Rich's decision described the law with respect to Section 2(f) of the Trademark Act in detail.

The court first dealt with the two cases relied upon by the Board. With respect to *In Re Bourns, supra,* a case involving the appearance of a potentiometer, they said that the mark was unregistrable resulting from considerations of utility rather than appearance. There was no showing in that case that appearance as a whole, or any element of it, was intended to indicate source or is capable of doing so. With respect *In Alan Wood Steel Co. v. Watson, supra,* and *Ex parte Alan Wood Steel Co.*, 101 U.S.P.Q 209 (P.O. Examiner in Chief), involving a mark that was a raised non-skid pattern produced on steel flooring, wherein 70 affidavits were filed to show that the design did in fact enable the affiants to recognize the plates as the product of the applicant, the mark was not registered. In affirming the decision of the Examiner in Chief, the District Court for the District of Columbia said that the configuration of goods sought to be registered was "utilitarian" or "functional," citing *The J.R. Clark Co. v. Murray Metal Products Co.,* 219 F.2d 313, 104 U.S.P.Q. 224 (CCPA 1955).

Judge Rich cited the following from the *Alan Wood Steel* case in the CCPA decision"

> Were the law otherwise, it would be possible for a manufacturer or dealer, who is unable to secure a patent on his product or on his design, to obtain a monopoly on an unpatentable device by registering it as a trademark. The potential consequences to the public might be very serious, because while a patent is issued for only a limited term, a trademark becomes the permanent property of its owner and secures for him a monopoly in perpetuity.

The CCPA agreed with the foregoing quote. It referred again to the *Alan Wood Steel* case with the following quote: "A novel shape or appearance that is functional in character may not acquire any secondary meaning that would render it subject to exclusive appropriation as a trademark. 113 U.S.P.Q. at 312."

Judge Rich then went on to explain how to determine whether a novel shape or appearance is "functional" or whether any shape that performs a utilitarian function falls in that category. He said that a functional feature has been defined in the *Restatement of the Law of Torts*, section 742, as a feature of goods which affects their purpose, action or performance, or the facility or economy of processing, handling or using them. He said that the courts have accepted this definition and have also held "functional" the shape, size or form of an article which contributes to its utility, durability or effectiveness or the ease with which it serves its function, citing cases.

Judge Rich went on to explain that the socioeconomic policy supported by the general law is the encouragement of competition by all fair means, and that encompasses the right to copy, very broadly interpreted, except where copying is unlawfully prevented by a copyright or patent. 129 U.S.P.Q. at 319. The CCPA explained that the only significance of the existence of an expired patent on the article copied is that it adds another reason for saying that the public has the right to copy it, it being basic to the

patent system that the public may copy when any term of a patent comes to an end, with certain exceptions. This right to copy is derived not from the patent law, but rather from the inherent right in the public under the general law except to the extent that the patent law may remove it.

The decision of the CCPA went on to explain that a registration on the Principal Register can only occur if the applicant would have a right under the general law to prevent others from using or copying it, absent a copyright or patent. The Lanham Act does not create trademarks, although it may create some new substantive rights in the trademarks. *Id.* at 319.

The court asked whether the applicant has the "exclusive right to use" the shape sought to be registered. The applicant, supported by affidavit evidence (corresponding to the survey in the present application to register the drawing of a keel cooler), gave a two-fold response: (a) that its alleged mark had "become distinctive of the applicant's goods in commerce," (the language of § 2(f), 15 U.S.C. 1052(f)); and (b) that it had acquired a "secondary meaning." *Id.* at 320. This is analogous to the application at hand to register the drawing of the GRIDCOOLER.

The decision of the CCPA made the following comments regarding § 2(f). The CCPA said:

> There is nothing whatever in the section [§ 2(f)] saying what shall be registered. It is purely negative, saying that if a mark has become distinctive, nothing "herein" shall prevent registration.... This leaves the question of trademark ownership, which is a prerequisite to registrability, to be determined by law other than section 2(f).

The court then referred back to an earlier-stated truism, that "A trademark distinguishes one man's goods [or services] from the goods [or services] of others; but not everything

that enables goods [or services] to be distinguished will be protected as a trademark." *Id.* at 320.

With respect to the "secondary meaning" aspect of the argument in the *Deister Concentrator* case, Judge Rich referred to an earlier cited truism that some trademarks are words or configurations which are protected because they have acquired a "secondary meaning"; but not every word or configuration that has a de facto "secondary meaning" is protected as a trademark. *Id.* at 320. The court said that courts will not support exclusive rights in any word or shape which, in their opinion, the public has the right to use in the absence of patent or copyright protection. In the present opposition, the patent rights in Fernstrum's GRIDCOOLER keel cooler have long since expired, and anyone could copy them absent some contract right to the contrary.

The court referred to the "Shredded Wheat" case, *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 39 U.S.P.Q. 296 (1938), where the Supreme Court said that the sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all, and in the free exercise of which the consuming public is deeply interested. 39 U.S.P.Q. at 300. The CCPA, still referring to the *Kellogg* case, said with respect to the name "Shredded Wheat," which was claimed to have acquired a secondary meaning:

> The evidence shows only that due to the long period in which the plaintiff or its predecessor was the only manufacturer of the product, many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff's factory at Niagara Falls. 39 U.S.P.Q. at 299.

Thus, "Shredded Wheat" had a de facto "secondary meaning" as an indication of source, but the court refused to attach any legal consequence to that "secondary meaning." The Supreme Court said that when an article may be manufactured by all, a particular

manufacturer can no more assert exclusive right in a form to which the public has become accustomed to see the article and which, in the minds of the public, is primarily associated with the article rather than with a particular producer. The Supreme Court said that the Kellogg Co. was free to use the pillow-shaped form of shredded wheat, subject only to the obligation to identify its product lest it be mistaken for that of the National Biscuit Co. The same rule should apply to the present case. Fernstrum should not be able to get a registration for the picture of a keel cooler, and anyone should be able to use it so long as they do not misrepresent the source of the keel coolers. The CCPA said that the public acceptance of a functional feature as an indication of source is therefore not determinative of right to register. Preservation of freedom to copy "functional" features is the determining factor.

With respect to functionality, the 80,000-100,000 models of keel coolers, including the one shown in Fernstrum's trademark application Serial No. 75/701,707, is, without question, functional. The keel cooler is the subject of U.S. Patent No. 2,382,218 (R.W. Fernstrum 1945). (Ex. 1, Dep. Ex. 61) Fernstrum conceded its claim that the coolant flow tubes with the rectangular cross section is functional in the litigation which took place in the District Court in New Orleans in 1998. The settlement agreement (Ex. 13) reflects the conclusion of that litigation. Duramax Marine has done extensive research into improving the one-piece keel cooler, as evidenced by its U.S. Patent No. 6,575,227 (Ex. 12). This keel cooler looks very much like the Fernstrum keel cooler shown in Serial No. 75/701,707. A photograph of the keel cooler of Duramax Marine is shown in Exhibit 35, Deposition Exhibit 24, and a line drawing of another model of the Duramax Marine keel cooler is shown in Exhibit 36, Deposition Exhibit 23. Photographs of a keel cooler made by East Park are shown in Exhibit 37, Deposition Exhibit 62.

The CCPA held in the *Deister Concentrator* case that the rhomboidal shape was functional. This was a two-dimensional drawing of a three-dimensional object, just like the application in the present opposition. The court said that they were not denying registration merely because the shape possesses utility, but because the shape is *in essence* utilitarian. The CCPA affirmed the decision of the Board.

VI. Conclusion

For the reasons set forth above, it is respectfully requested that the present opposition be sustained and that the registration of Serial No. 75/701,707 be refused. The drawing of the keel cooler shown in the trademark application is a drawing of the product sold by Fernstrum, and is therefore merely descriptive under § 2(e)(1) of the Trademark Act. The survey that had been filed by Fernstrum in an attempt to convert the application to one under § 2(f) of the Trademark Act was fatally defective in that those who took part in the survey were not shown anything that resembled the drawing of Serial No. 75/701,707. Moreover, as explained in *In re Deister Concentrator Company, Inc., supra,* the drawing of a product which is in essence utilitarian cannot be registered.

Respectfully submitted,

Date: June 27, 2003

By: _____
D. Peter Hochberg
Reg. No. 24,603

DPH/ck
Att.: Exhibits

D. Peter Hochberg co., L.P.A.
1940 East 6th Street – 6th Floor
Cleveland, Ohio 44114
Phone: (216) 771-3800 / Fax: (216) 771-3804